

Notice of Allowability

Application No.

10/537,307

Examiner

Yong Chu

Applicant(s)

POETSCH ET AL.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 11/6/2006.
2. ☒ The allowed claim(s) is/are 1-3 and 5-25 (renumbered as 1-24).
3. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☒ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO/SB/08),
Paper No./Mail Date _____
4. ☐ Examiner's Comment Regarding Requirement for Deposit
of Biological Material
5. ☐ Notice of Informal Patent Application
6. ☐ Interview Summary (PTO-413),
Paper No./Mail Date _____
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____

DETAILED ACTION

Claim 4 was canceled by the Amendment filed on November 6, 2006. Claims 24 and 25 are new. Therefore, claims 1-3, and 5-25 are pending in this application.

Response to Amendment

The Amendments by Applicants' representative Brion P. Heaney dated on November 6 2006 has been entered.

Rejection under 35 U.S.C. §112, first paragraph

Applicant's arguments over rejection of claim 1 under 35 U.S.C. §112, first paragraph enablement filed on November 6, 2006 have been considered, and are found persuasive. Therefore, the rejection over claim 1 is withdrawn.

Applicant's arguments over rejection of claims 1-3, and 5-23 under 35 U.S.C. §112, first paragraph enablement filed on November 6, 2006 have been considered, and are found persuasive. Therefore, the rejection over claim 1-3, and 5-23 is withdrawn.

Rejection under 35 U.S.C. §112, second paragraph

The rejection of claims 1-7, 9-10,18, and 21 under 35 U.S.C. §112 second paragraph is moot after considering the amendment of carboxylic acid derivative to their salts. Therefore, the rejection over claims 1-7, 9-10,18, and 21 is withdrawn.

The rejection of claims 8,19, and 20 under 35 U.S.C. §112 second paragraph is moot after considering the amendment of carboxylic acid derivative to their salts.

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Therefore, the rejection over claims 8, 19, and 20 is withdrawn.

The rejection of claim 1 under 35 U.S.C. §112 second paragraph is moot after considering the deleting "C₁ unit". Therefore, the rejection over claim 1 is withdrawn.

The rejection of claim 9 under 35 U.S.C. §112 second paragraph is moot after considering the amendment of halonium equivalents to halonium.". Therefore, the rejection over claim 9 is withdrawn.

Rejection under 35 U.S.C. §103(a)

Applicant's argument on the ground that McMurray described converting 1-bromo-2,4,6-trimethylbenzene into 2,4,6-trimethylbenzoic acid, and having no disclosure of suggestion of a Grignard reaction involving a cycloaliphatic ring system such as 2,6-disubstituted trans-decalin has been considered and persuasive. Therefore, the rejection over the claims 1-6 under 103(a) is withdrawn.

Examiner's amendment

An examiner's amendment to the record appears. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it **MUST** be submitted no later than the payment of the issue fee.

The application has been amended as follows:

In claim 8 line 2 of the Supplementary Amendment filed on 6 November 2006, delete "a" after "carboxylic acid or salt of ", and insert --said--.

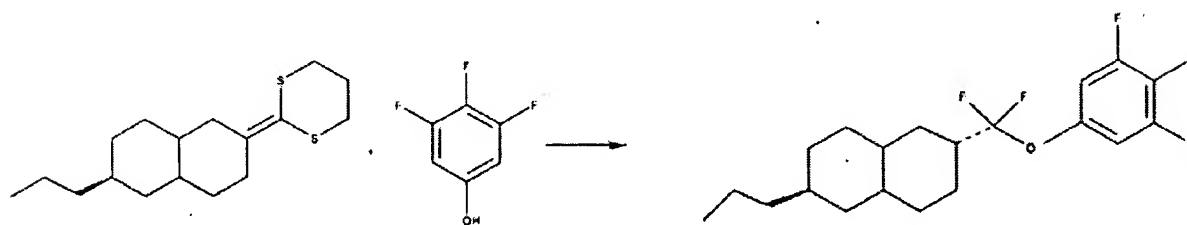
In claim 12 line 2 of the Supplementary Amendment filed on 6 November 2006,

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delete "a" after "carboxylic acid or salt of ", and insert --said--.

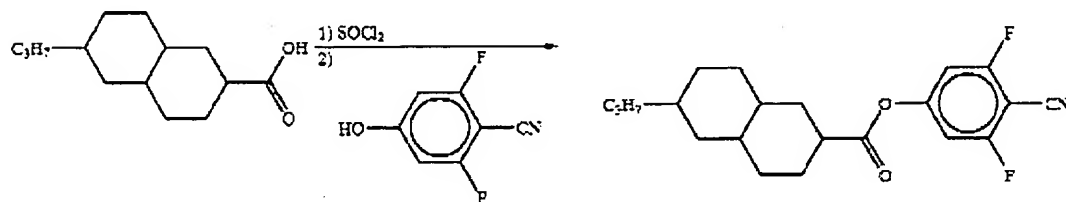
Reasons for Allowance

The present invention is directed to a process for preparing a compound of formula (I) $R-(A^1-Z)_m-B-CF_2O-A^2-(A^3)_n-R'$ with more specific example of



comprising converting a compound of formula(II) $R-(A^1-Z)_m-BX$ into a carboxylic acid or a salt of a carboxylic acid with elimination of the group X; and converting said carboxylic acid or a salt of a carboxylic acid using a phenol of formula (III) $HO-A^2-(A^3)_n-R'$ to obtain a compound of formula (I).

The closest prior art of record is U.S. Patent 6,913,797 (Ogawa et al.). Ogawa et al. disclose a process to make a related compound of formula



The prior art process is patentably distinct from the instantly claimed processes in terms of the final products made and the process used for making the intermediates. The product made by the prior art process has ester linker between fluoro-substituted

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phenyl and the trans-decalin, in contrary with the product made by the instantly claimed process has difluoromethylene ether linker between fluoro-substituted phenyl and the trans-decalin.

Therefore, claims 1-3, and 5-25 are allowed.

Telephone Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yong Chu whose telephone number is 571-272-5759. The examiner can normally be reached on 7:00 am - 3:30 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane can be reached on 571-272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

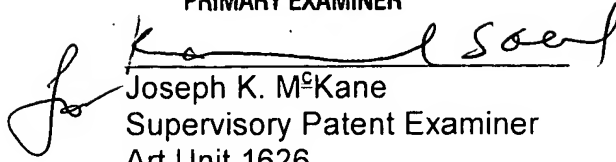
Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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